

**TRANSMITTAL LETTER
(General - Patent Pending)**

Docket No.
LEAP:127US

In Re Application Of: **Bonaventura et al.**

| Application No. | Filing Date | Examiner | Customer No. | Group Art Unit | Confirmation No. |
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| 10/733,628 | 12/11/2003 | Arnel C. Lavarias | 24041 | 2872 | 1669 |

Title: **MICROSCOPE STAGE CONTRASTING MEANS**

COMMISSIONER FOR PATENTS:

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Dated: **March 27, 2007**


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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Russell BONAVENTURA et al.

Examiner: Arnel C. LAVARIAS

Application No.: 10/733,628

Group Art Unit: 2872

Filed: December 11, 2003

Confirmation No. 1669

Attorney Docket No.: LEAP:127US

Customer No.: 24041

For: MICROSCOPE STAGE CONTRASTING
MEANS

Appeal No.: 2006-3285

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SUPPLEMENTAL APPEAL BRIEF UNDER 37 C.F.R. § 41.37

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Honorable Sir:

Appellants respectfully appeal from the decision of the Primary Examiner to finally reject Claims 1-6, 9-15 and 17-20, as set forth in the Final Office Action dated November 8, 2005. A Notice of Appeal and Pre-Appeal Brief Request for Review were timely filed by the Appellants on February 6, 2006. An Appeal Brief was filed on April 10, 2006, along with payment of the \$500.00 filing fee; an Examiner's Answer was mailed on May 24, 2006; and, subsequently a Reply Brief was filed on July 21, 2006. In response to a telephonic communication on September 11, 2006 from Ester Dove, a paralegal of the United States Patent and Trademark Office, a Supplemental Appeal Brief was facsimile filed on September 11, 2006 including a previously omitted Evidence Appendix. The Board issued an Order Remanding the case to the Examiner on February 12, 2007 wherein the Examiner was instructed to notify the Appellants of the non-compliant Brief and require submission of a Brief in Compliance with 37 C.F.R. § 41.37. This Supplemental Appeal Brief is filed in response to the Notification of Non-Compliant Appeal Brief dated February 28, 2007.

Attorney Docket No.: LEAP:127US
U.S. Patent Application No.: 10/733,628
Supplemental Appeal Brief dated March 27, 2007

A Claims Appendix follows page 21 of this paper.

An Evidence Appendix follows page 24 of this paper.

A Related Proceedings Appendix follows page 25 of this paper.

REAL PARTY IN INTEREST

The real party in interest is Leica Microsystems Inc., Assignee of the above application by assignment recorded in the Patent and Trademark Office at Reel 014812, Frame 0004.

RELATED APPEALS AND INTERFERENCES

Upon information and belief, no appeals or interferences known to Appellant, which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

STATUS OF CLAIMS

The application originally contained 20 claims.

Claims 7, 8 and 16 have been canceled.

Claims 1-6, 9-15, and 17-20 stand as finally rejected.

Claims 1-6, 9-15 and 17-20 are the subject of this Appeal.

STATUS OF AMENDMENTS

No amendments were filed subsequent to final rejection. However, Appellants did file a Request for Reconsideration on January 3, 2006, but the Examiner concluded it did not place the application in condition for allowance. In addition, Appellants filed a Pre-Appeal Brief Request for Review with supporting arguments. The Pre-Appeal Conference Panel held that Appellants should proceed to the Board of Patent Appeals and Interferences.

SUMMARY OF THE CLAIMED INVENTION

The present invention relates generally to microscopes, and more particularly to microscope stages having contrasting means that allow a user to orient a specimen thereon, prior to insertion of the specimen into the optical path.

Claim 1

Claim 1 recites a microscope stage that allows a user to orient a specimen thereon prior to insertion of the specimen into the optical path. (See generally Page 1, Lines 3-5; Page 2, Lines 8-16). The microscope stage includes upper stage **26** having a first color and recess **32** therein, and further includes non-transparent contrasting stage insert **28** having a second color that is different color from the first color. (Fig. 3, Reference Nos. **26**, **28** and **32**; Page 5, Lines 4-22). Stage insert **28** is configured for removable complementarily receipt within recess **32**. (Fig. 2 and 3, Reference Nos. **28** and **32**; Page 5, Lines 20-23; Page 6, Line 1).

Claim 6

Claim 6 is a dependent claim, and therefore, includes all the limitations of the claims from which it depends, *i.e.*, Claims 1 and 4. In view of the foregoing, Claim 6 recites a microscope stage that allows a user to orient a specimen thereon prior to insertion of the specimen into the optical path. (See generally Page 1, Lines 3-5; Page 2, Lines 8-16). The microscope stage includes upper stage **26** having a first color and recess **32**, **40** or **44** therein, and further includes non-transparent contrasting stage insert **28**, **38** or **42**, respectively, each insert having a second color that is different color from the first color. (Figs. 2 and 3, Reference Nos. **26**, **28** and **32**; Figs. 4 and 5, Reference No. **26**, **38** and **40**; Figs. 6 and 7, Reference No. **26**, **42** and **44**; Page 5, Lines 4-22; Page 6, Lines 14-18). Stage insert **28** is configured for removable complementarily receipt within recess **32**, while stage insert **38** is configured for removable complementarily receipt within recess **40** and stage insert **42** is configured for removable complementarily receipt within recess **44**. (Fig. 2 and 3, Reference Nos. **28** and **32**; Figs. 4 and 5, Reference No. **38** and **40**; Figs. 6 and 7, Reference No. **42** and **44**; Page 5, Lines 20-23; Page 6, Lines 1 and 14-18). Non-transparent contrasting stage insert **28** further includes releasable fastening means **36**, while non-transparent contrasting stage inserts **38** and **42** each further include releasable fastening means. (Fig. 2 and 3, Reference Nos. **28** and **36**; Page 6, Lines 6-8 and 18-21). Releasable fastening means **36** and each releasable fastening means included with

non-transparent contrasting stage inserts **38** and **42** include magnets, hook and loop type fasteners, detents, springed ball bearings, or the like. (Page 6, Lines 8-9 and 18-21).

Claim 9

Claim 9 recites a microscope stage that allows a user to orient a specimen thereon prior to insertion of the specimen into the optical path. (See generally Page 1, Lines 3-5; Page 2, Lines 8-16). The microscope stage includes upper stage **26** having a first color, and non-transparent contrasting stage insert **28** having a second color, wherein stage insert **28** includes a portion of upper stage background. (Fig. 2, Reference Nos. **26** and **28**; Page 5, Lines 4-17).

Claim 17

Claim 17 recites a device for providing a contrast between a microscope stage and a specimen. The device comprises microscope stage **24** including non-transparent contrasting stage insert **28** having a first color and a specimen having a second color, wherein the first color and the second color are different. (Fig. 3, Reference Nos. **24** and **28**; Page 5, Lines 10-14).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether Claims 1-5 and 9-15 (which are separately patentable) are non-obvious under 35 USC §103(a) to a person having ordinary skill in the art at the time the invention was made and therefore patentable over U.S. Patent No. 5,306,467 (Douglas-Hamilton et al.) in view of U.S. Patent No. 5,781,338 (Kapitza et al.)?

2. Whether Claim 6 is non-obvious under 35 U.S.C. §103(a) to a person having ordinary skill in the art at the time the invention was made and therefore patentable over U.S. Patent No. 5,306,467 (Douglas-Hamilton et al.) in view of U.S. Patent No. 5,781,338 (Kapitza et al.), and in further view of U.S. Patent No. 4,436,385 (Fischer et al.)?

3. Whether claims 17-20 (which are separately patentable) are non-obvious under 35 U.S.C. §103(a) to a person having ordinary skill in the art at the time the invention was made and therefore patentable over U.S. Patent No. 5,306,467 (Douglas-Hamilton et al.) in view of U.S. Patent No. 4,906,083 (Sattler)?

ARGUMENT

1) Whether Claims 1-5 and 9-15 (which are separately patentable) are non-obvious under 35 USC §103(a) to a person having ordinary skill in the art at the time the invention was made and therefore patentable over U.S. Patent No. 5,306,467 (Douglas-Hamilton et al.) in view of U.S. Patent No. 5,781,338 (Kapitza et al.)?

a) Summary of the Rejection:

The Examiner rejected Claims 1-5 and 9-15 under 35 USC §103(a) as being unpatentable over U.S. Patent No. 5,306,467 (Douglas-Hamilton et al.) in view of U.S. Patent No. 5,781,338 (Kapitza et al.). More specifically, the Examiner asserted:

Regarding Claim 9, Douglas-Hamilton et al. discloses a microscope stage comprising an upper stage and a non-transparent contrasting stage insert comprising a second color. The non-transparent stage insert comprises a portion of the upper stage background. The upper stage comprising a recess and the non-transparent contrasting stage insert being operatively arranged for releasable complementarily receipt therein. Douglas-Hamilton et al. does not explicitly disclose the upper stage comprising a first color. However, Kapitza et al. discloses a microscope stage comprising an upper stage comprising a first color, e.g., black as by black lacquer paint including a recess therein. Regarding Claim 1, Douglas-Hamilton et al. discloses the invention set forth above in Claims 9, except for a non-transparent contrasting stage insert that is explicitly removable. However, Douglas-Hamilton et al. additionally discloses that the non-transparent stage insert may be inserted into the upper stage by inserting the lateral extensions on the legs of the stage insert into the bores in the recess of the upper stage, and it would have been obvious to remove the upper stage taught in Douglas-Hamilton et al. by disengaging the lateral extensions on the legs of the stage insert from the bores of the recess of the upper stage. Thus, it would have been obvious to have the non-contrasting stage insert be removable, to allow for quick removal and replacement of the insert.

Appellants respectfully request reversal of the Examiner's rejection of Claims 1-5, and 9-15 for the reasons set forth below.

b) Brief description of the references cited by the Examiner

For purposes of providing background, Appellants briefly discuss the references cited by the Examiner.

1) Douglas-Hamilton et al.

Douglas-Hamilton et al. disclose an apparatus for measuring cell concentration in a biological sample that includes slide holder 10 which may be disc-shaped or rectangular with central axis 12 passing through the center of the disk on an axis normal to the plane of slide holder 10. Slide holder 10 has recess 14 extending across the diameter of slide holder 10. Recess 14 extends far enough to accommodate slide 21. Holder clamp 20 couples to slide holder 10 for retaining slide 21 and coverslip 23 in position within recess 14.

2) Kapitza et al.

Kapitza et al. disclose a microscope stage which permits pre-orientation by the user with respect to specimens present on the stage, due to glass fibers 13, condenser lenses 9 and 10, and light-scattering layer 12 positioned on top of base 7. Transparent plane-parallel ceramic glass-plate 11 is inserted in a recess in base 7 on the objective side. Specimens 6 can be placed on the upper side of glass-plate 11. Brightly colored, light scattering surface 12 is provided between plate 11 and base 7. Illumination of the preparation, *i.e.*, specimen 6, is provided as uniformly as possible, even in regions outside the illuminating field defined by condenser 8. Glass fibers 13 conduct a portion of the illuminating light and subsequently couple the light into end faces 11a of plate 11. Specimen 6 is brightly illuminated by the light reflecting from the brightly colored, light-scattering layer 12.

c) Arguments regarding the rejection of Claims 1 and 9

Appellants contend that **Claims 1-5 and 9-15 are separately patentable**. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in knowledge generally available to one having ordinary skill in the art, to modify the reference or combine reference teachings.

Second, there must be a reasonable expectation of success. *Finally, the prior art reference (or the references when combined) must teach or suggest all the claim limitations.* The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." MPEP § 2142 (citing *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991)) (emphasis added).

1) There is no motivation provided for combining Douglas-Hamilton et al. and Kapitza et al.

The rejection of Claims 1 and 9 over Douglas-Hamilton et al. in view of Kapitza et al., provides no rational basis for combining the references. The recognized law for combining references to support the conclusion that the claimed combination of structural features is directed to obvious subject matter requires that either the references expressly or impliedly teach or suggest the claimed combination, or the Examiner must present a convincing line of reasoning as to why an artisan would have found the claimed invention to have been obvious in light of the teachings of the references. See, for Example, *Ex parte Clapp* 227 USPQ 972 (973) (PTO Br Pat. App. & Int. 1985); *In re Geiger* 2 USPQ2d 1276 (CA, Fed. Cir. 1987). In this regard, the Final Office Action mentions that Kapitza et al. disclose an upper microscope stage having a first color (black) with a recess therein. Then, immediately concludes it would be obvious to one of ordinary skill in the art to modify the upper stage of the slide loading apparatus for measuring the number of cells in a fluid biological specimen of Douglas-Hamilton et al. by following the teachings of Kapitza et al. Importantly, no rationale or explanation was provided in the Final Office Action how the teachings of the two references, Douglas-Hamilton et al. and Kapitza et al. were selected and combined, nor has the Examiner provided a convincing line of reasoning providing a basis for combining Douglas-Hamilton et al. and Kapitza et al. independent of Appellants' own disclosure. As Examiner has provided no basis for combining the references, Appellants courteously submit that the combination of these references is impermissible hindsight reconstruction, based on a prior reading of Appellants' own disclosure.

2) Douglas-Hamilton et al. does not teach or suggest a microscope stage

In arriving at a conclusion of obviousness, one is required to view the prior art taken as a whole. See *W.L. Gore & Associates, Inc. v. Garlock, Inc.* 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983). The Examiner has asserted that Douglas-Hamilton et al. disclose a microscope stage. However, Douglas-Hamilton et al. describe placing the slide loading apparatus onto the stage of a microscope. Thus, if the Douglas-Hamilton et al. device is placed on a microscope stage it cannot also be a microscope stage as recited in Appellants' Claims 1 and 9. Furthermore, Douglas-Hamilton et al. do not illustrate a microscope in their drawings, nor do they describe a microscope in their specification. Contrarily, in col. 5, lines 7-15, they describe that their slide loading device is more conducive for use with manual microscopy, and states that: "it becomes more important that the specimen is as close to the microscope condenser as possible in order to maintain the use of the full range of available illumination optics." Hence, the slide loading device of Douglas-Hamilton et al. is not a microscope stage, nor can it be used in place of a microscope stage. Instead, the reference teaches that the device is used by placing it onto the stage of a microscope. Thus, Douglas-Hamilton et al. do not expressly teach or suggest their device is a microscope stage, but instead disclose that their device is a slide loading apparatus (Fig. 1) for use in automated cell counting systems or for use with standard optical microscopes for measuring the number of cells in a fluid biological sample.

"If a claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). The preambles of Claims 1 and 9 explicitly state "a microscope stage" is an essential component of the claims that further defines the structure of the article claimed and therefore recites a limitation for both claims. Ignoring the phrase "microscope stage" in the preambles of Claims 1 and 9 would extract meaning from those claims and would eliminate a limitation from the claims. The other structures recited in those claims are disposed on a microscope stage, not on some other structure. Without the preamble of Claims 1 and 9, there is no context to understand

the structure recited in the claims and the claims would have broader scope than as they are currently composed. In short, Appellants' courteously assert that Claims 1 and 9 would be structurally different without the preambles reciting "a microscope stage". Hence, Appellants' respectfully submit the Examiner erred in failing to accord weight to Appellants' preamble which expressly recites: "A microscope stage".

Furthermore, according to the Examiner's Advisory Action of January 13, 2006, a preamble is not given significant patentable weight unless structurally distinguishable. The failure to accord patentable weight to Appellants' preamble therefore contradicts the Examiner's own admission. The Examiner acknowledges that Douglas-Hamilton et al. do not fully anticipate the rejected claims at the bottom of page 3 of the Final Office Action wherein he states, "Douglas-Hamilton et al. do not explicitly disclose the upper stage comprising a first color, as required by the rejected claims." Because Appellants' claimed device is structurally distinguishable over Douglas-Hamilton et al., the failure to accord weight to the finally rejected claims reciting a "microscope stage" in the preamble was a substantial reversible error.

Kapitza et al. fail to teach the elements cited above that are absent from Douglas-Hamilton et al. Although, Kapitza et al. is cited by the Examiner as teaching a microscope stage comprising an upper stage comprising a first color, *e.g.*, black as black lacquer paint and including a recess therein, Kapitza et al. do not cure the deficiencies of Douglas-Hamilton et al., in particular, by teaching a non-transparent contrasting stage insert. Thus, the combination of Douglas-Hamilton et al. and Kapitza et al. fail to teach or suggest all the limitations of Claims 1 and 9.

Additionally, Appellants' respectfully submit that during prosecution before the Office, claims are given their broadest reasonable interpretation consistent with the specification and the prior art. Compare *In re Finsterwalder*, 58 CCPA 871, 436 F. 2d 1028, 168 USPQ 530 (CCPA 1971). Also see *In re Sneed*, 710 F.2d 1544, 218 USPQ 385 (Fed. Cir.1983). The slide loading apparatus of Douglas-Hamilton et al. used for measuring the number of cells in a fluid biological sample bears no structural resemblance to Appellants' claimed "microscope stage" for creating a contrast with a specimen so that the specimen can be more easily viewed prior to

insertion into the optical path. The explanation of claim language provided by the Examiner must bear some rational connection to the way the language is employed in Appellants' specification, or to the meaning it would be given by a person of ordinary skill in the subject art. See e.g., *In re Gordon* 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). The fact that Douglas-Hamilton et al. teach a slide loading apparatus which can be placed onto the stage of a microscope, and includes a U-shaped holder clamp which enters a recess in the slide holder for holding the slide/specimen in place seated in the recess, has no bearing on the structural features of Appellants' device, nor on the utility and objective of enabling a user to orient a specimen on a stage. In short, the device of Douglas-Hamilton et al. has no relevance to Appellants' claimed invention, i.e., a "microscope stage".

Appellants respectfully submit that the combination of Douglas-Hamilton et al. and Kapitza et al. do not disclose, teach or suggest each and every limitation of Claims 1 and 9, in particular, an upper stage having a first color and a non-transparent contrasting stage insert having a second color different from the first color. Therefore, Claims 1 and 9 are patentable over Douglas-Hamilton et al. and Kapitza et al. In generally follows that Claims 2-4 and 10-15, which are dependent from Claims 1 and 9, respectively, are also patentable over Douglas-Hamilton et al. and Kapitza et al, due to their dependency therefrom. In view thereof, Appellants request that the Board reverse the Examiner's rejections.

3) The combination of Douglas-Hamilton et al. and Kapitza et al. fail to teach, suggest or motivate the non-transparent contrasting stage insert of Appellants' Claims 1 and 9 and claims dependent therefrom

Holder clamp **20** of Douglas-Hamilton et al. is not a contrasting stage insert comprising a second color according to Appellants' Claims 1 and 9. Douglas-Hamilton et al. teach that holder clamp **20** is a U-shaped retainer clamp pivotally mounted to the slide holder and designed to apply pressure to the cover slip and slide. Nothing is disclosed by Douglas-Hamilton et al. that teaches or suggests that U-shaped retainer clamp **20** can provide a background color for contrast against a specimen that is being positioned on an upper stage. Appellants courteously assert that

the claim term “contrasting” indicates the stage insert contrasts with the specimen placed thereon. This interpretation is fully supported by the written description provided in the instant application. “When evaluating the scope of a claim, every limitation in the claim must be considered,” however, Appellants respectfully submit that the limitation that the stage insert is contrasting was not fully considered by the Examiner. See, *e.g.*, *In re Ochiai*, 71 F.3d 1565, 1575, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995). Moreover, this limitation is not taught or suggested by Douglas-Hamilton et al., or by Kapitza et al.

Additionally, Appellants’ Claims 1 and 9 recite a non-transparent contrasting stage insert that is a second color which is different from the first color of the upper stage. Contrarily, Douglas-Hamilton et al. fail to disclose an upper stage and a contrasting stage insert that has these features. Structurally, U-shaped retainer clamp 20 of Douglas-Hamilton et al. does not meet the criteria for a non-transparent contrasting stage insert, as taught in Appellants’ Claims 1 and 9. In addition, Douglas-Hamilton et al. fail to disclose a non-transparent contrasting stage insert that is “complementary” with the recess, according to Claim 1 of Appellants’ application. Similarly, Kapitza et al. fail to cure these defects. In view of the foregoing, elements of Appellants’ Claims 1 and 9 are not taught or suggested by Douglas-Hamilton et al. or Kapitza et al., *i.e.*, an upper stage comprising a first color and a non-transparent contrasting stage insert comprising a second color, and therefore Claims 1 and 9 are non-obvious in view of Douglas-Hamilton et al. and Kapitza et al.

Moreover, even if holder-clamp 20, embedded in recess 14, was a second contrasting color, which it is not, it would still not provide the contrasting feature that is recited in Claims 1 and 9 since it is a U-shaped clamp that functions as a clamp for retaining the slide under pressure, not a background surface to provide contrast for orienting a specimen. The contrasting colors of the stage insert and the upper stage, even if present in Douglas-Hamilton et al., which they are not, would be inoperable as contrasting backgrounds to aid in the positioning of specimen. This is because a slide in Douglas-Hamilton et al. is not positioned over holder 10 and clamp 20, but is positioned inside the U-shaped void of clamp 20 over recess 14 and aperture 18. The structural arrangements of the elements of the invention disclosed by Douglas-Hamilton et

al. and Kapitza et al. are completely different from the structure recited in Claims 1 and 9. Appellants respectfully assert that the disclosure by Kapitza et al. does not repair the deficiencies of the patent from Douglas-Hamilton et al., *i.e.*, including a non-transparent contrasting stage insert.

2) Whether Claim 6 is non-obvious under 35 U.S.C. §103(a) to a person having ordinary skill in the art at the time the invention was made and therefore patentable over U.S. Patent No. 5,306,467 (Douglas-Hamilton et al.) in view of U.S. Patent No. 5,781,338 (Kapitza et al.), and in further view of U.S. Patent No. 4,436,385 (Fischer et al.)?

a) Summary of the Rejection:

The Examiner rejected Claim 6 under 35 USC §103(a) as being unpatentable over U.S. Patent No. 5,306,467 (Douglas-Hamilton et al.) in view of U.S. Patent No. 5,781,338 (Kapitza et al.), and in further view of U.S. Patent No. 4,436,385 (Fischer et al.). More specifically, the Examiner asserted:

Douglas-Hamilton et al. in view of Kapitza et al. discloses the invention as set forth in Claims 1, 4 and 9 except for the releasable fastening means comprising a springed detent. However, the use [of] adhesive films, magnets/magnetic surfaces and springed detents for use as releasable fastening means to allow for easy removal and attachment of items is well known and conventional in the art. For example, Fischer et al. teaches a conventional specimen holder for use in microscopes, wherein slidable holders for holding a specimen is releasably held in place at a particular position by springed detents. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the releasably fastening means comprise a spring detent, as taught by Fischer et al., in the microscope stage taught of Douglas-Hamilton et al. in view of Kapitza et al., to provide for precise and accurate positioning of the insert, while allowing for quick removal and replacement of the insert when needed.

b) Brief description of the references cited by the Examiner

For purposes of providing background, Appellants briefly discuss the references cited by the Examiner.

1) Douglas-Hamilton et al.

Please refer to ARGUMENT section 1(b)(1) supra, for a description of Douglas-Hamilton et al.

2) Kapitza et al.

Please refer to ARGUMENT section 1(b)(2) supra, for a description of Kapitza et al.

3) Fischer et al.

Fischer et al. disclose a specimen holder for inverted microscopes which consists of plates **2a** and **2b** that are arranged in pairs and guided by ledges **15a**, **15b**, **15c** and **15d**. Spring wires **21a** and **21b** are intended for the adjustment of plates **2a** and **2b**, and V-shaped indentations **5a** and **5b** on the plates are arranged to grasps Petri dish **17**.

c) Arguments regarding the rejection of Claim 6

As set forth above, “To establish a prima facie case of obviousness, ... *the prior art reference (or the references when combined) must teach or suggest all the claim limitations.*” MPEP § 2142 (citing *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991)) (emphasis added).

1) The combination of Douglas-Hamilton et al., Kapitza et al. and Fischer et al. fail to teach, suggest or motivate all of the elements of Appellant’s Claim 6

The Examiner asserted in the Final Office Action that Douglas-Hamilton et al. disclose the invention as set forth in Claim 1 except for the releaseable fastening means comprising a springed detent. The Examiner cited Fischer et al. as teaching a conventional specimen holder for use in microscopes wherein slidable holders, used to hold specimens, are releasably held in place at a particular position by springed detents. However, Fischer et al. do not disclose a stage insert with a releasable fastening means comprising a springed detent, rather, they disclose a spring means for controlling the spacing of the V-shaped plates to avoid inadvertent dropping of a specimen slide.

While Fischer et al. teach the use of springed detents, this structural feature lacks the “releasable” properties associated with Appellants’ detent, and therefore, fails to meet the limitations of claim 6. Finally, it is impermissible within the framework of 35 U.S.C. 103 to pick and choose structural feature(s) from a collection of references to meet the limitation of claim 6, and exclude other features of the reference(s) because they are not needed. That is, the selection of the detent of Fischer et al. to the exclusion of other elements of the device of Fischer et al. is a violation of the rule against hindsight reconstruction where the invention becomes obvious after having the benefit of a prior reading of Appellants’ own disclosure. See *In re McLaughlin* 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971).

Furthermore, although there is no requirement that an “express, written motivation to combine must appear in prior art references before a finding of obviousness,” the absence of an express motivation can carry weight in some instances to counter an obviousness rejection. See *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1276, 69 USPQ2d 1686, 1690 (Fed. Cir. 2004). In this instance there is no express motivation to combine Douglas-Hamilton et al., Kapitza et al. and Fischer et al. and thus this fact raises doubt as to whether one of ordinary skill in the art would combine these three references. Coupling this with the assertion that releasable springed detents are recited in Claim 6, there is ample support that an element of Claim 6 is not taught by the cited references.

Accordingly, the combination of Douglas-Hamilton et al, Kapitza et al and Fischer et al fail to make out the requisite *prima facie* case of obviousness under 35 U.S.C. 103(a). Appellants respectfully submit that the combination of Douglas-Hamilton et al. and Kapitza et al. do not disclose, teach or suggest each and every limitation of Claim 6, e.g., a springed detent. Therefore, Claim 6 is patentable over Douglas-Hamilton et al., Kapitza et al. in view of Fischer et al. Therefore, Appellants request that the Board reverse the Examiner’s rejection.

3) Whether Claims 17-20 (which are separately patentable) are non-obvious under 35 U.S.C. §103(a) to a person having ordinary skill in the art at the time the invention was made and therefore patentable over U.S. Patent No. 5,306,467 (Douglas-Hamilton et al.) in view of U.S. Patent No.4,906,083 (Sattler)?

a) Summary of the Rejection:

The Examiner rejected Claims 17-20 under 35 USC §103(a) as being unpatentable over U.S. Patent No. 5,306,467 (Douglas-Hamilton et al.) in view of U.S. Patent No. 4,906,083 (Sattler). More specifically, the Examiner asserted:

Regarding Claim 17, Douglas-Hamilton et al. discloses a device for providing a contrast between a microscope stage and a specimen comprising a microscope stage comprising a non-transparent contrasting stage insert having a first color and a specimen. It is well known in the art that many specimens examined by microscopes will have some color, which may be different from that of the stage (e.g. black) and/or a stage insert (e.g. silver, black). For example, Sattler teaches a conventional microscope for examining gemstones, wherein the gemstones may have a color that is different from the microscope stage or the sample holder/insert on which the sample is placed. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made for the specimen [to] have a second color [that is] different from the first color of the non-transparent contrasting stage insert, as taught by Sattler, in the device of Douglas-Hamilton et al., to allow for higher contrast, while maintaining or reproducing accurate and true color of the specimen, during viewing of the specimen.

b) Brief description of the references cited by the Examiner

For purposes of providing background, Appellants briefly discuss the references cited by the Examiner.

1) Douglas-Hamilton et al.

Please refer to ARGUMENT section 1(b)(1) supra, for a description of Douglas-Hamilton et al.

2) Sattler

Sattler discloses an apparatus for examining gemstones including microscope stage **10** that is mounted on support plate **24**. Below microscope stage **10** is glassfiber bundle **46** that can be illuminated by a source of cold light. Slide-type specimen holder **54** that is made of a transparent material is inserted within microscope stage **10**. The specimen holder allows light to travel through it and allows the light to enter gemstones **70a**, **70b** and **70c**, which are held on specimen holder **54**.

c) Arguments regarding the rejection of Claims 17-20

Appellants contend that **Claims 17-20 are separately patentable**. As stated *supra*, Douglas-Hamilton et al. fail to teach or suggest a microscope stage, specifically, a microscope stage comprising a non-transparent contrasting stage insert having a first color. In like fashion, Sattler is also silent regarding these missing elements. Moreover, the Examiner has not asserted that Sattler includes any of these missing elements. In fact, Sattler has been cited by the Examiner merely to support an assertion that “it would have been obvious to one having ordinary skill in the art at the time the invention was made for the specimen [to] have a second color be different from the first color of the non-transparent contrasting stage insert, as taught by Sattler, in the device of Douglas-Hamilton et al., to allow for higher contrast, while maintaining or reproducing accurate and true color of the specimen, during viewing of the specimen.”

1) There is no credible motivation provided for combining Douglas-Hamilton et al. and Sattler

The rejection of Claims 17-20 over Douglas-Hamilton et al. in view of Sattler (US Pat. 4,906083), provides no rational basis for combining the references. The recognized law for combining references to support the conclusion that the claimed combination of structural features is directed to obvious subject matter requires that either the references expressly or impliedly teach or suggest the claimed combination, or the Examiner must present a convincing line of reasoning as to why an artisan would have found the claimed invention to have been

obvious in light of the teachings of the references. See, for Example, *Ex parte Clapp* 227 USPQ 972 (973) (PTO Br Pat. App. & Int. 1985); *In re Geiger* 2 USPQ2d 1276 (CA, Fed. Cir. 1987).

As previously discussed, the device of Douglas-Hamilton et al. is not a microscope stage, as alleged, but instead performs and contains structural features specifically designed for measuring cell concentration in a biological specimen. The device is seated on a microscope stage, as discussed above and not used in place of a stage. It is erroneous to correlate, for example, holder clamp 20 of Douglas-Hamilton et al., with Appellants' non-transparent contrasting stage insert because Appellants' non-transparent contrasting stage insert is not designed or disclosed as possessing the property of applying and exerting uniform pressure on the edges of a coverslip overlying a specimen volume. This is a key feature of Douglas-Hamilton et al.'s device that is neither used nor needed according to Appellants' invention. Also, the cited references do not disclose a non-transparent contrasting stage insert with a color that is different from the upper stage. As previously stated, the Patent and Trademark Office, in the process of examining claims, gives claims their broadest reasonable interpretation consistent with the specification and the prior art. The selection of the Douglas-Hamilton et al. device as meeting the limitation's goes well beyond the "broadest reasonable interpretation" standard in extending the specific structural features of the slide loading device of Douglas-Hamilton et al. to the structural features of Appellants' claims 17-20. Hence, even if Sattler teaches the features wherein the gemstones may have a color different from a microscope stage, as alleged in the Official Action, Claims 17-20 would still not be arrived at because the structural features of the slide loading device of Douglas-Hamilton et al. simply does not meet the limitations of Appellants' claims.

The Examiner asserts that the motivation to combine Douglas-Hamilton et al. with Sattler is to "allow for higher contrast, while maintaining or reproducing accurate and true color of the specimen, during viewing of the specimen." The invention recited in Claim 17 is intended to provide a contrast between a specimen and a microscope stage to aid in the orienting of a specimen on a microscope stage prior to looking through the objective. Since orienting a specimen under magnification can be difficult, the contrasting stage insert provides a means to position a specimen without having to look through an objective. The motivation that the

Examiner cites for combining Sattler with Douglas-Hamilton et al. is related to providing a higher contrast to aid in the image that is provided by the microscope. The contrast in color between the specimen and the contrasting stage insert that is recited in Claim 17 has nothing to do with providing a better image quality. Better image quality is entirely unrelated to the motivation for having a contrasting stage insert that is a different color from the specimen as recited in Claim 17. Hence, the Examiner has cited no credible motivation for combining Douglas-Hamilton et al. with Sattler.

Appellants respectfully submit that the combination of Douglas-Hamilton et al. and Sattler do not disclose, teach or suggest each and every limitation of Claim 17. Therefore, Claim 17 is patentable over Douglas-Hamilton et al. and Sattler. It generally follows that Claims 18-20, which are dependent from Claim 6, are also patentable over Douglas-Hamilton et al. and Sattler, due to their dependency therefrom. In view of the foregoing discussion, Appellants request that the Board reverse of the rejection of claims 17-20 as unpatentable over Douglas-Hamilton et al. in view of Sattler.

2) The combination of Douglas-Hamilton et al. and Sattler fails to teach, suggest or motivate the non-transparent contrasting stage insert of Appellants' Claim 17 and claims dependent therefrom

Not only does Sattler not repair the defects of the Douglas-Hamilton et al. reference, it also fails to teach the element that the Examiner asserts that it teaches. The Examiner points to reference number 54 in Figures 1 and 2 (Col. 4, Line 60; Col. 6, Line 2) of Sattler as evidence that it discloses a *non-transparent* contrasting stage insert being different from the second color of the specimen. The written description of Sattler, which outlines the structure of the element designated as reference number 54, contradicts the Examiner's assertion that Sattler teaches the non-transparent contrasting stage insert recited in Claim 17. In Col. 4, Lines 55-65 the specimen holder, which the Examiner cites as an equivalent of the *non-transparent* contrasting stage insert, is described as a structure that is light-permeable and translucent, i.e., transparent. Again in Col. 11, Lines 38-46 of Sattler it restates that light can travel through the specimen holder. This

feature of the specimen holder in Sattler is in direct conflict with Claim 17, where Appellants state that the stage insert is *non-transparent*. Appellants request that the Board take judicial notice that the commonly accepted definition of transparent is to allow light to travel through it. Thus, a *non-transparent* specimen holder would not allow light to travel through it. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. See *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Sattler suggests the direct opposite of the structural arrangement recited in Claim 17 and as a result Appellants have rebutted the evidence provided by the Examiner to support the obviousness rejection of Claim 17. Therefore, a prima-facie case of obvious has not been established for Claim 17.

CONCLUSION

For the reasons set forth above, Appellants respectfully submit that Claims 1-5 and 9-15 are non-obvious under 35 U.S.C. §103(a) to a person having ordinary skill in the art at the time the invention was made and therefore patentable over U.S. Patent No. 5,306,467 (Douglas-Hamilton et al.) in view of U.S. Patent No. 5,781,338 (Kapitza et al.). Additionally, Appellants respectfully submit that Claim 6 is non-obvious under 35 U.S.C. §103(a) to a person having ordinary skill in the art at the time the invention was made and therefore patentable over U.S. Patent No. 5,306,467 (Douglas-Hamilton et al.) in view of U.S. Patent No. 5,781,338 (Kapitza et al.), and in further view of U.S. Patent No. 4,436,385 (Fischer et al.). Lastly, Appellants respectfully submit that Claims 17-20 are non-obvious under 35 U.S.C. §103(a) to a person having ordinary skill in the art at the time the invention was made and therefore patentable over U.S. Patent No. 5,306,467 (Douglas-Hamilton et al.) in view of U.S. Patent No. 4,906,083 (Sattler). Accordingly, Appellants pray that this Honorable Board reverse the Primary Examiner's rejection of Claims 1-6, 9-15 and 17-20.

Respectfully submitted,



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RCA/HME/
Attachment

CLAIMS APPENDIX

Reprinted herebelow are the claims involved in this appeal:

1. A microscope stage comprising:
an upper stage comprising a first color; said upper stage comprising a recess therein; and
a non-transparent contrasting stage insert comprising a second color different from said first color; said non-transparent contrasting stage insert configured for removable complementarily receipt within said recess.
2. The microscope stage of Claim 1 wherein said non-transparent contrasting stage insert comprises alignment means for aligning said contrasting stage insert within said recess.
3. The microscope stage of Claim 2 wherein said alignment means comprises a recess pin and a contrasting stage insert bore.
4. The microscope stage of Claim 1 wherein said non-transparent contrasting stage insert comprises releasable fastening means.
5. The microscope stage of Claim 4 wherein said releasable fastening means comprises a magnet.
6. The microscope of Claim 4 wherein said releasable fastening means comprises a springed detent.
9. A microscope stage comprising:
an upper stage comprising a first color; and
a non-transparent contrasting stage insert comprising a second color, said non-transparent contrasting stage insert comprising a portion of said upper stage background.

10. The microscope stage of Claim 9 wherein said non-transparent contrasting stage insert comprises a painted surface.
11. The microscope stage of Claim 9 wherein said non-transparent contrasting stage insert comprises a magnetic surface.
12. The microscope stage of Claim 9 wherein said non-transparent contrasting stage insert comprises an adhesive film.
13. The microscope stage of Claim 9 wherein said upper stage comprises a recess and said non-transparent contrasting stage insert is operatively arranged for releasable complementary receipt therein.
14. The microscope stage of Claim 13 wherein said non-transparent contrasting stage insert further comprises alignment means.
15. The microscope of Claims 13 wherein said non-transparent contrasting stage insert further comprises fastening means.
17. A device for providing contrast between a microscope stage and a specimen comprising:
 - a microscope stage comprising a non-transparent contrasting stage insert having a first color;
 - a specimen comprising a second color;said first color of said non-transparent contrasting stage insert being different from said second color of said specimen.

Attorney Docket No.: LEAP:127US
U.S. Patent Application No.: 10/733,628
Supplemental Appeal Brief dated March 27, 2007

18. The device of Claim 17 wherein said non-transparent contrasting stage insert is releasably secured to said microscope stage.

19. The device of Claim 17 wherein said non-transparent contrasting stage insert comprises a releasable fastening means.

20. The device of Claim 19 wherein said fastening means comprises a magnet.

Attorney Docket No.: LEAP:127US
U.S. Patent Application No.: 10/733,628
Supplemental Appeal Brief dated March 27, 2007

EVIDENCE APPENDIX

Appellants courteously submit that no additional evidence is being submitted with this Appeal Brief.

Attorney Docket No.: LEAP:127US
U.S. Patent Application No.: 10/733,628
Supplemental Appeal Brief dated March 27, 2007

RELATED PROCEEDINGS APPENDIX

Upon information and belief, no appeals or interferences known to Appellants, which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.